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09/783,666	02/14/2001	Reiner Kraft	ARC920010009US1	9116

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Technology Center 2100

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/783,666
Filing Date: February 14, 2001
Appelant(s): KRAFT ET AL.

Reiner Kraft
<u>For Appellant</u>

EXAMINER'S ANSWER

This is in response to the supplemental appeal brief filed 05/09/2007.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the

brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which

will directly affect or be directly affected by or have a bearing on the

decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is

correct.

(4) Status of Amendments

The appellant's statement of the status of amendments after final

rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is

correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed

on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,948,040	Delorme	9-1999
6,026,388	Liddy	2-2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-28 rejected under 35 U.S.C. 103(a) as being unpatentable over

DeLorme et al. (5,948,040) (hereinafter DeLorme) in view of Liddy et al.

(6,026,388) (hereinafter Liddy).

As per claims 1 and 21, DeLorme discloses a method for automatic

relevance-based preloading data to a computing device (Col. 48, lines 5-33),

comprising:

identifying any one or more of persons or current scheduled tasks prior

to the occurrence of the tasks (Fig. 5, Col. 48, lines 47-67);

analyzing the relevance of stored data (Col. 49, lines 1-6) to any one

or more of the current scheduled tasks or persons (Col. 49, lines 1-32);

sorting the stored data based (Col. 49, lines 51-59) upon the

relevance to any one or more of the current scheduled tasks or persons (Col.

49, lines 33-59);

setting a predetermined relevance threshold (Col. 48, lines 5-33, zip

code, phone exchange areas are setting relevance threshold), and

automatically preloading (pre-arranged, Col., 46, lines 55-67, Col. 48,

30-33, transferring is preloading) selected sorted data to the computing

device (Col. 48, lines 25-33) with a higher (array, sorting, Fig. 6, Col. 53,

lines 1–44) than the relevance threshold (intended departure time, when,

where, who to visit, or what to do, are the inherent threshold values in the

context of this invention, Fig. 6, Col. 5, line 61, Col. 53, lines 15-44,Col. 48,

lines 5-33).

wherein analyzing comprises estimating a proximity of the stored data items

to any one or more of persons or current scheduled tasks (POI/EOI,

Optimally arranged output, EOI arrays, Col. 53, lines 15-43 Col. 17, lines 1-

44), based on an association proximity measure and at least one proximity

measure (Col. 17, lines 1-44, Col. 22, lines 10-37).

DeLorme fails to disclose relevance score.

However, Liddy discloses relevance score (Col. 4, lines 1-2).

Therefore, it would have been obvious to one of ordinary skill in the art

at the time invention was made to combine the teachings of Liddy with

DeLorme because it would provide optimal trip planner and the proximity

decision will be based on the relevance score.

As per claim 2, DeLorme discloses analyzing the relevance includes

estimating a proximity of the stored data items to the any one or more of

persons or current scheduled tasks, based on the combination of three

proximity measures distance, time, association (POI/EOI, Col.17, lines 1-44,

Col. 22, lines 19-37).

As per claim 3, DeLorme discloses step of analyzing the relevance further
includes combining the at least three proximity measures into a single
relevance (POI/EOI, Col.17, lines 1-44, Col. 22, lines 19-37).

DeLorme fails to disclose relevance score.

However, Liddy discloses relevance score (Col. 4, lines 1-2).

Therefore, it would have been obvious to one of ordinary skill in the art
at the time invention was made to combine the teachings of Liddy with
DeLorme because it would provide optimal trip planner and the proximity
decision will be based on the relevance score.

As per claim 4, DeLorme discloses step of analyzing the relevance includes
analyzing the proximity of information items to any one or more of the
current scheduled tasks or persons (Col. 22, lines 19-37 and Col. 21-57 and
Col. 19, lines 9-67).

As per claim 5, DeLorme discloses wherein the step of analyzing the
proximity of information items includes measuring proximity in terms of **a**
(Col. 22, lines 19-37 and Col. 21-57 and Col. 19, lines 9-67) combination of
the association measure along with any one of location and/or time
(POI/EOI, Optimally arranged output, EOI arrays, Col. 53, lines 15-43 Col.
17, lines 1-44).

As per claim 6, DeLorme discloses preloading selected sorted data to the computing device includes preloading the data to a communication device (Col. 12, lines 1-16).

As per claim 7, DeLorme discloses preloading the data to the communication device includes preloading the data to a mobile telephone (Col. 16, lines 32-52).

As per claim 8, DeLorme discloses preloading the data to the communication device includes preloading the data to a personal digital assistant (PDA) device (Col. 16, lines 32- 52).

As per claim 9, DeLorme discloses the step of preloading the data includes preloading the data to a personal computer (Col. 14, lines 20-67).

As per claim 10, DeLorme discloses identifying any one or more of current scheduled tasks or persons includes identifying events scheduled in a user's calendar, locations, and/or time frames (Col. 59, lines 35-67).

As per claims 11 and 19, DeLorme discloses a system for automatic relevance-based preloading information items to a computing device, comprising (Col. 48, lines 5-33):

a proximity estimator (Col. 32, lines 46-67) that determines a proximity of the information items to a user's task based on a combination of measures comprised at least an association proximity measure (POI/EOI, Col.17, lines 1-44, Col. 22, lines 19-37) and any one or more of two proximity measures: distance and time (Col. 22, lines 19-37),

a relevance estimator (Col. 32, lines 46-67) that combines the combination of measures into a single relevance (POI/EOI, Col.17, lines 1-44, Col. 22, lines 19-37);

an information retriever (Col. 32 lines 61-67) that retrieves information items (Col. 32 lines 61-67) with a relevance score higher than a predetermined threshold relevance (Col. 48, lines 5-33, zip code, phone exchange areas are setting relevance threshold); and

a device loader that processes (Col. 32 lines 61-67) the information items retrieved by the information retriever and automatically preloads (pre-arranged, Col. 46, lines 55-67, Col. 48, 30-33, transferring is preloading, Col. 14, lines 20-30) the retrieved information items to the computing device (Col. 14, lines 20-30 and Col. 12, lines 10-16).

DeLorme fails to disclose relevance score.

However, Liddy discloses relevance score (Col. 4, lines 1-2).

Therefore, it would have been obvious to one of ordinary skill in the art

at the time invention was made to combine the teachings of Liddy with

DeLorme because it would provide optimal trip planner and the proximity

decision will be based on the relevance score.

As per claims 12 and 22, DeLorme discloses further including an information

catalog that contains a list of the information items to which a user has

access (classified geographical points of interest, Col. 47, lines8-59, Col. 28,

lines 1-55, and Col. 24, lines 1-28).

As per claims 13, 20, and 23, DeLorme discloses the relevance estimator

combines the combination of measures into a single relevance by weighting

each of the proximity measures (Col. 75, lines 1-32) forming part of the

combination.

DeLorme fails to disclose relevance score.

However, Liddy discloses relevance score (Col. 4, lines 1-2).

Therefore, it would have been obvious to one of ordinary skill in the art

at the time invention was made to combine the teachings of Liddy with

DeLorme because it would provide optimal trip planner and the proximity

decision will be based on the relevance score.

As per claims 14 and 24, DeLorme discloses the relevance estimator

combines the combination of measures (POI/EOI, Col.17, lines 1-44, Col.

22, lines 19-37) into a single relevance by computing a geometric mean of

the proximity measures (Col. 75, lines 1-32) forming part of the combination

of measures (array, sorting, Fig. 6, Col. 53, lines 1–44).

DeLorme fails to disclose relevance score.

However, Liddy discloses relevance score (Col. 4, lines 1-2).

Therefore, it would have been obvious to one of ordinary skill in the art

at the time invention was made to combine the teachings of Liddy with

DeLorme because it would provide optimal trip planner and the proximity

decision will be based on the relevance score.

As per claim 15, DeLorme discloses the distance proximity measure includes

a difference between a user's planned location for a given task and a

location of a scheduled task (Col. 75, lines 1-32).

As per claims 16 and 26, DeLorme discloses the time proximity measure

denotes immediacy of user's tasks (Col. 54, lines 57-67, Col. 72, lines 1-44).

As per claims 17 and 27, DeLorme discloses the association proximity

measure denotes persons and contacts associated with a location and

purpose of a given task (Col. 55, lines 20-29, Col. 72, lines 1-60).

As per claims 18 and 28, DeLorme discloses including a location tracker that

determines the user's location (Fig. 9, Col. 55, lines 20-51, Col. 72, lines 1-

7).

New Grounds of Rejection

An interview was conducted with agent of record, Samuel A. Kassatly

(Reg. No. 32,247), on June 09, 2005, regarding 101 issues to claims 11,19,

and 21. Attorney indicated that it was not necessary to reopen the

prosecution. Claims 11-18,19-20, and 21-28 does not include tangible

elements resulting in a practical application.

Claim Rejections - 35 USC § 101

Claims 11-18,19-20, and 21-28 are rejected under 35 U.S.C. 101

because the claimed invention is directed to non-statutory subject matter.

The language of the claims raises a question as to whether the claims are

directed merely to an abstract idea that does not include tangible elements

resulting in a practical application (i.e. computer program is not stored on a

computer readable medium). The various estimators, retriever, and loader

are software constructs performing various functionalities (see brief Page 2,

Summary of claimed subject matter). These functionalities do not

manipulate any hardware or tangible entity. Therefore, these software

constructs are non statutory entities as detailed in MPEP 2106.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and
> distinctly claiming the subject matter which the applicant regards as his invention.

Claims 19-20 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject

matter which applicant regards as the invention. The proper test for meeting

the definiteness requirement is that the corresponding structure (or material

or acts) of a means (or step)-plus-function limitation must be disclosed in

the specification itself in a way that one skilled in the art will understand

what structure (or material or acts) will perform the recited function.

Claims 19-20 are rejected under 35 U.S.C. 112, sixth paragraph (see brief,

page 6), written description necessary to support a claim limitations. SIXTH

PARAGRAPH 35 U.S.C. 112, sixth paragraph states that a claim limitation

expressed in means-plus-function language "shall be construed to cover the

corresponding structure...described in the specification and equivalents

thereof." "If one employs means plus function language in a claim, one must

set forth in the specification an adequate disclosure showing what is

meant by that language. If an applicant fails to set forth an adequate

disclosure, the applicant has in effect failed to particularly point out and

distinctly claim the invention as required by the second paragraph of section

112." In re Donaldson Co., 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850

(Fed. Cir. 1994) (in banc).

(10) *Response to Argument*

Examiner has cited particular columns and line numbers in the

references, as applied to the claims, above for the convenience of the

applicant. Although the specified citations are representative of the

teachings of the art and are applied to the specific limitations within the

individual claim, other passages and figures may apply as well. It is

respectfully requested from the applicant in preparing responses, to fully

consider the references in their entirety as potentially teaching all or part of

the claimed invention, as well as the context of the passage as taught by the

prior art or disclosed by the Examiner.

DeLorme et. al., like Appellant, describes to schedule or reserve (col 49, lines 10-20) a trip by identifying the area of interest (col 50, lines 3-8), system chooses restaurant from all of the stores in the area of the interest (col 48, lines 19-26; col 50, lines 3-20) and provides the functionality to transfer the data items of the scheduled trip or reservation to the handheld device prior to the event (scheduled trip, col 48, lines 30-33).

In Brief the Appellant argues that:

Argument: Threshold does not require any further clarification (see brief, Page 8).

Response: According to the Appellant description of "threshold" in the context of claims it is used as a filtering criteria ("a relevance score higher than the relevance threshold"). Applicant's argument is persuasive, which also has clarified the functionality of the term "setting threshold", therefore, the objection is withdrawn.

Argument: DeLorme does not disclose automatic relevance-based preloading data (page 14).

Response: DeLorme's disclose automatic relevance-based preloading (preloading relates to loading prior to some event or action. However claim is silent about such event and action. *Prior system allows* to schedule or

reserve a trip, col 49, lines 10-20, by identifying the area of interest to, col

50, lines 3-8; system selects the restaurant from all of the stores in the area

of the interest, col 48, lines 19-26; col 50, lines 3-20; provides the

functionality to transfer the data items of the scheduled trip or reservation to

the handheld device prior to the scheduled trip, col 48, lines 19-33).

Argument: DeLorme does not disclose analyzing the relevance (page 15).

Response: In response to the Appellants arguments, Delorme teaches

analyzing the relevance of the stored data to any or more of the currently

scheduled tasks or person (...by addition of temporal and/or transactional

travel information and database... Col. 49, lines 2-3; lines 10-20; col 50,

lines 3-8) which is similarly disclosed in the applicant's specification on page

2, lines 20-22. It is the examiner's understanding that a planned trip in itself

is a scheduled task.

Argument: DeLorme does not disclose sorting based upon the relevance

(page 16).

Response: DeLorme's system further discloses POIs situated around a

single location, a set of points or a computed route in TRIPS can further be

sorted or filtered by topical, temporal, and/or transactional criteria--as

detailed elsewhere in this disclosure, particularly regarding FIG. 8B. (Col. 49, lines 51-55).

In response to the Appellants arguments, DeLorme teaches the sorting based upon the relevance to any one or more of the current scheduled task (Col. 49, lines 51-55). DeLorme reference reiterates the sorting and filtering techniques which happens to be a well known process in the software and database art.

Argument: DeLorme does not disclose setting a predetermined relevance threshold (page17)

Response: In response to the Appellants arguments, DeLorme teaches setting a predetermined threshold (topically classified in the area of interest, col 48, lines 19-23;*Prior system allows* to schedule or reserve a trip, col 49, lines 10-20, by identifying the area of interest to, col 50, lines 3-8; system selects the restaurant from all of the stores in the area of the interest, col 48, lines 19-26; col 50, lines 3-20; provides the functionality to transfer the data items of the scheduled trip or reservation to the handheld device prior to the scheduled trip, col 48, lines 19-33).

Argument: DeLorme fails to disclose relevance score, and automatic preloading based on relevance score that is higher than the relevance threshold (page 18).

Response: Examiner respectfully disagrees, DeLorme teaches automatically preloading (preloading relates to loading prior to some event or action. However claim is silent about such event and action. ...pre-arranged, *Prior system allows* to schedule or reserve a trip, col 49, lines 10-20, by identifying the area of interest to, col 50, lines 3-8; system selects the restaurant from all of the stores in the area of the interest, col 48, lines 19-26; col 50, lines 3-20; provides the functionality to transfer the data items of the scheduled trip or reservation to the handheld device prior to the scheduled trip, col 48, lines 19-33) selected sorted data to the computing device with a higher than the relevance threshold (topically classified in the area of interest, col 48, lines 19-23;*Prior system* allows to schedule or reserve a trip, col 49, lines 10-20, by identifying the area of interest to, col 50, lines 3-8; system selects the restaurant from all of the stores in the area of the interest, col 48, lines 19-26; col 50, lines 3-20; provides the functionality to transfer the data items of the scheduled trip or reservation to the handheld device prior to the scheduled trip, col 48, lines 19-33).

Argument: DeLorme does not disclose analyzing based on the association

proximity and at least one proximity measure (page 19).

Response: In response to the applicant's arguments, DeLorme teaches the

analyzing comprises estimating a proximity of the stored data items to any

one or more of persons or current scheduled tasks, based on an association

proximity measure and at least one proximity measure (...POI/EOI, Optimally

arranged output, EOI arrays, temporal data... Col. 17, lines 1-44;Col. 53,

lines 15-43; topically classified in the area of interest, col 48, lines 19-

23;*Prior system allows* to schedule or reserve a trip, col 49, lines 10-20, by

identifying the area of interest to, col 50, lines 3-8; system selects the

restaurant from all of the stores in the area of the interest, col 48, lines 19-

26; col 50, lines 3-20; provides the functionality to transfer the data items

of the scheduled trip or reservation to the handheld device prior to the

scheduled trip, col 48, lines 19-33) which is similarly disclosed in the

applicant's specification on pages 3 and 4, where the applicant describes

temporal, distance, and association proximities. Furthermore, Liddy

discloses relevance score (Col. 4, lines 1-2). It would have been obvious to

one of ordinary skill in the art at the time invention was made to combine

the teachings of Liddy with DeLorme because it would provide optimal trip

planner and the proximity decision will be based on the relevance score.

Argument: The combination of DeLorme and Liddy does not disclose the present invention.

Response: examiner disagrees for similar reasons as stated above.

For all these reasons, representative claim 1, is properly rejected under U.S.C. 103(a) as being unpatentable over DeLrome et al. in view of Liddy et et. al. Independent claims 11, 19, and 21 are properly rejected for the same reasons as discussed above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.
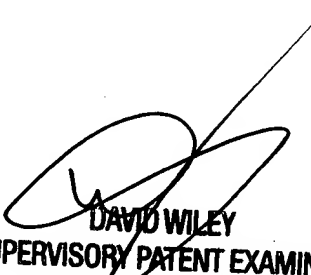
For the above reasons, it is believed that the rejections should be sustained

Respectfully submitted,

Mohammad Siddiqi
Examiner
Art Unit 2154
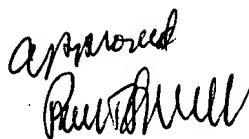August 19, 2007

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